



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#16
NB 3-11-03

In re Application of:)
Jack LORRAINE, et al.)
Application No.: 09/313,407) Group Art Unit: 3747
Filed: May 18, 1999) Examiner: C. Miller
For: FUEL INJECTOR MOUNTING)
ARRANGEMENT)

Commissioner for Patents
Washington, D.C. 20231

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Sir:

REQUEST FOR RECONSIDERATION
UNDER 37 C.F.R. § 1.111

TECHNOLOGY CENTER R3700

In response to the non-final Office Action mailed **December 04, 2002**, which period for response extends through March 04, 2003, reconsideration of the application in view of the following remarks is requested.

The non-final Office Action has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. Accordingly, Applicants request reconsideration of the pending claims 1-18.

Claims 1-18 stand rejected under 35 U.S.C. § 112, first paragraph, as containing new matter. In particular, the Office Action asserts that because the specification fails to provide a written description that conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, the features recited in claims 1, 8, 12, and 15 constitute new matter.

Applicants respectfully assert that the recitation of relative lengths of the wall and the leg(s) along the longitudinal axis is not new matter because, at the time of filing of this application, the inventors had possession of the claimed invention such that recitation of this feature does not constitute new matter. As stated in MPEP §2163, "[a]n applicant shows



possession of the claimed invention by describing the claimed invention ... using such descriptive means as words, structures, figures, diagrams and formulas that fully set forth the claimed invention." For example, the exemplary components of the fastener 18 or clip 40 are depicted in Figs. 2, 3 and 4 in a manner that is believed to illustrate the size of each feature relative to each other.

That is, the length (which has been labeled as **L1** for demonstrative purpose) of the wall 42 (Fig. 2) along the longitudinal axis 22 is less than the length (which has also been labeled as **L2** for demonstrative purpose) of each leg (42a or 42b) along the longitudinal axis 22 has been illustrated in the exemplary embodiment of originally-filed Fig. 3 or Fig. 4 (reproduced at right) so as to render unnecessary an explicit textual description of the relative sizes of these components. Furthermore, one skilled in the art would appreciate that the originally filed Figures 1-4 illustrate the relative sizes of the features of the clip so as to clearly support the recited features, and that the originally filed application, including the drawings, unequivocally conveys that the inventors had possession of the claimed invention such that recitation of this feature is not new matter. Accordingly, the rejection for allegedly adding new matter under 35 U.S.C. § 112, first paragraph, should be withdrawn.

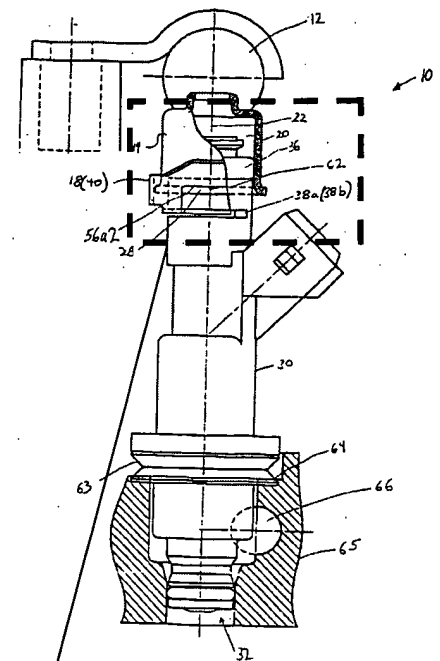
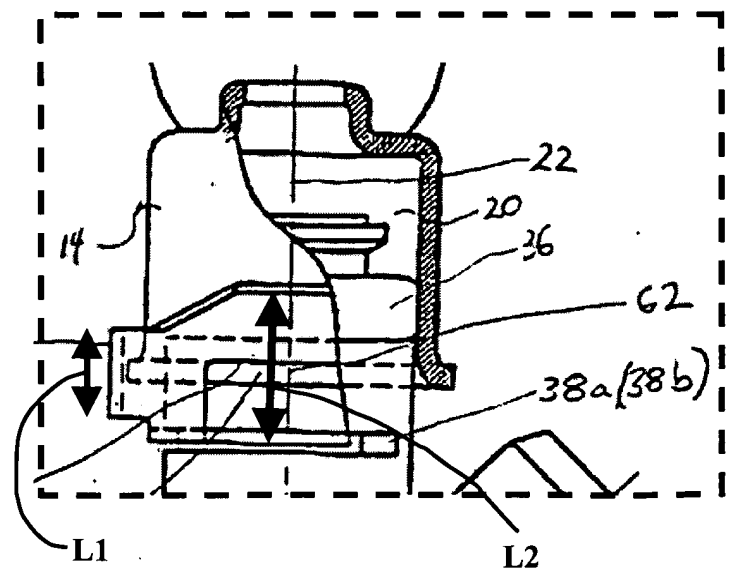


Fig. 4



Claims 1-10 and 12-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,136,999 to Bassler *et al* ("Bassler") in view of U.S. Patent 6,019,089 to Taylor *et al* ("Taylor"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bassler and Taylor and in view of U.S. Patent 5,752,487 to Harrell *et al* ("Harrell").

Applicants respectfully traverse this rejection because Bassler or Taylor, singularly or in combination, fails to teach or suggest the claimed invention as a whole, as recited in claims 1, 8, 12, and 15.

Each of the independent claims 1, 8, 12, and 15 recites, *inter alia*, a wall and a pair of legs of a fastener (or a clip) projecting from the wall of the fastener or clip. Further, a length of the wall along a longitudinal axis is less than the length of each leg with respect to the longitudinal axis.

In sharp contrast, Bassler states, at column 3, lines 11-20, that two segments 27, 28 extend from the web member 20 that interconnects spring legs 18 and 19. As shown in Figure 3 of Bassler, the length of the segments 27 (being part of the web 30) extends beyond a length of the either spring leg 18 or 19 as referenced to the longitudinal direction of the fuel injector of Bassler. Thus, a length of the web 20 (shown as segments 27) of Bassler along the longitudinal direction is greater than a length of each of the spring leg 18 or 19 as referenced with respect to the longitudinal direction in Bassler **instead** of being less than the length of each leg as recited in claims 1, 8, 12, and 15.

Notwithstanding the deficiencies in Bassler, the Office Action asserts that it would have been obvious to modify Bassler based upon the teachings of Taylor in an attempt to provide for the claimed invention as a whole. Bassler states, at column 3, lines 39-44, that a spring clip 17 locks the fuel injection valve 12 in an axial direction (via openings 25 and 26) and in a circumferential direction (via segments 27 and 28 of spring web 20). That is, Bassler relies on the length of the segments 27 and 28 of a spring web 20 extending along a longitudinal axis to hold the fuel injection valve 12 circumferentially via an axial rib 31 provided on the connecting piece 11. Taylor, on the other hand, states, at column 4, lines 10-15, that an orientation tab 46 extends from the body 44 and a shorter tab 48 also extends from the body 44. The orientation tabs 46 of Taylor provide for a circumferential holding feature. The tab 48 of Taylor connects

the two orientation tabs 46. Further, the tab 48 of Taylor is apparently not used to provide a circumferential holding feature because the tab 48 orients away from a fuel cup 32 such that the tab 48 is not retained to the fuel cup 32. That is to say, Bassler provide for a circumferential holding feature by a component (i.e., spring web 20) that connects two spring legs 18 and 19, whereas Taylor provides for a similar component (i.e., tab 48) between two orientation tabs 46 that does not provide for a holding feature. Therefore, Applicants submit that the proposed combination of Bassler and Taylor could render the circumferential holding feature of the segments 27, 28 of web 20 (column 3, lines 58-61) of Bassler inoperative due to the non-holding feature of the tab 48 of Taylor and thus, could render Bassler unsuitable for its intended purpose. And as noted in MPEP § 2143.01, “[i]f the proposed modification would render the prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Accordingly, the rejection to claims 1, 8, 12, and 15 should be withdrawn, because the claimed invention as a whole recites features not taught or suggested by Bassler or Taylor, singularly or in combination thereof.

The Office Action further relies upon the teachings of Harrell in combination with Bassler and Taylor in an attempt to provide for the mounting arrangement of claim 11. Harrell, however, fails to cure the deficiencies identified above in Bassler or Taylor. Accordingly, claim 11 is patentable over Bassler, Taylor or Harrell, singularly or in combination thereof.

Claims 2-7, 9, 10, 13, 14 and 16-18 depend ultimately from respective independent claims 1, 8, 12 and 15, are therefore also allowable for at least the same reason as claims 1, 8, 12, and 15, as well as for reciting additional features.

Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and allowance of claims 1-18. Applicants respectfully invite the Examiner to contact the undersigned at (202) 739-5203 if there are any outstanding issues that can be resolved via a telephone conference.

EXCEPT for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

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Date: 04 March 2003

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